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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,245	12/13/2001	Bin Takigawa	S002-4503	1504

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ADAMS & WILKS
31st Floor
50 Broadway
New York, NY 10004

EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/017,245

Applicant(s)

TAKIGAWA, BIN

Examiner

Judy M. Reddick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03/16/04 & 04/16/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 11 and 18 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3 and 8 is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7,9,10 and 12-17 is/are rejected.
- 7) ☒ Claim(s) 3 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 11 & 18 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention. Claims added by amendment following action by the examiner, MPEP § 818.01, § 818.02(a), to an invention other than previously claimed, should be treated as indicated by 37 CFR 1.145 which states, in essence, "If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in § 1.143 and 1.144.

Specification

2. The disclosure is objected to because of the following informalities: On page 2 @ line 25, it is believed tht "2-butane" should read "2-butanone", consistent with at least the Examples of the Specification.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As far as the Examiner can tell, no express support can be found for the newly added limitation "oils" and this, as such, engenders a New Matter situation. It is suggested that Applicant revert

back to the original claim language, i.e., "terpenic oil". An apology is extended for any confusion that the previous 112, 2nd paragraph issue may have caused.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims (15 and 16)/12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recited "the functional agent" per claims 15 and 16 constitute indefinite subject matter as per the non-establishment of proper antecedent basis.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1, 2, 4-7, 9, 10, 12-14, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinohara et al (U.S. 5,425,804) in combination with JP 56062861 A (Okano).

Shinohara et al teach a water-repellent glazing agent, suitable for treatment or polishing of the coated surface of automobiles and the surface of plastic, rubber, glass, etc., wherein the water-repellent glazing agent is defined, basically, as containing A) 0.5 to 20 weight % of a modified organic silicone oil(col. 1, lines 5-68 and col. 2, lines 1-14), sufficient to meet the silicone oil per claims 1, 6 & 12, B) solvent which includes hydrocarbon solvents such as heptane, mineral spirits and solvent naphtha, chlorohydrocarbon solvents such as trichloroethane, silicone solvents such as dimethyl silicone, alone or combinations of two or more, sufficient to meet the first and second solvents per claims 1, 6 and 12 and C) optional ingredients which include lower alcohols, polishing agents, surfactants, waxes which include carnauba wax, higher aliphatic acid esters such as cetyl palmitate, myricyl palmitate, higher amides such as acetamide, alone or combinations of two or more, sufficient to meet the amide compound and fatty acid alkyl ester compound per claims 1, 6 and 12(col. 2, lines 14-61, col. 3, lines 13-65 and col. 4, lines 3-8). Shinohara et al further teach the preparation of the water-repellent glazing agent which involves mixing the above described modified organic silicone oil, a solvent specified above and an optional ingredient or ingredients simultaneously or successively in an arbitrary order and, preferably, mixing the modified organic silicone oil and a solvent and then adding the optional ingredient or ingredients. See also, the Runs and claims of Shinohara et al.

Okano(Abstract) teaches a water-repellent glazing agent, suitable for an automobile body, capable of forming a uniform permanent spread film without causing a color shading on the coated surface, and defined basically as comprising polymethyl methacrylate in a solution of a specific component, e.g. amino-modified silicone oil, in a solvent. More specifically, Okano teaches a process for preparing the water-repellent glazing agent, which basically involves dissolving amino-modified silicone oil, dimethylsilicone oil and a high-melting wax such as carnauba wax in a solvent, e.g. solvent Naphtha, to form a solution, and dissolving polymethyl methacrylate in the solution and subsequently mixing mineral spirit with the solution to give the aimed water-repellent glazing agent.

The disclosure of Shinohara et al differs basically from the claimed invention in that there is no direct disclosure of an embodiment teaching the further addition of a polymethyl methacrylate component to the water-repellent glazing agent recipe. However, one having ordinary skill in the art, based on their similar recipes and uses, would have found it obvious to add the polymethyl methacrylate component of the water-repellent glazing agent recipe taught by Okano to the water-repellent glazing agent recipe of Shinohara et al and with a reasonable expectation of enhancing the properties of the water-repellent glazing agent such as gloss, i.e., a reasonable expectation of success, absent a clear showing of unexpected results commensurate in scope with the claims.

As to the specific steps recited per claims 6-10, the selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results. In re Burhans, 154 F.2d 690, 69 USPQ, 330 (CCPA 1946).

As to the utility of the amide compounds and higher aliphatic acid esters of Shinohara et al as a clearing agent and functional agent, respectively, since the amide compound and aliphatic acid ester compound is the same as the inventive amide compound and fatty acid alkyl ester compound, it must necessarily possess the claimed properties. Moreover, it is not necessary in order to establish a prima facie case of obviousness that there be a suggestion or expectation from the prior art that the claimed compound will have the same or a similar utility as one newly discovered by applicant. Consult In re Dillon 16 USPQ2d 1897. See also In re Papesch, 315 F.2d 381, 391, 137 USPQ 43, 51 (CCPA 1963), a compound and all its properties are inseparable. Furthermore, as to any remaining properties (1, 6 & 12), "The fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious." Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985) (The prior art taught combustion fluid analyzers which used labyrinth heaters to maintain the samples at a uniform temperature. Although appellant showed an unexpectedly shorter response time was obtained when a labyrinth heater was employed, the Board held this advantage would flow naturally from

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following the suggestion of the prior art.). See also *Lantech Inc. v. Kaufman Co. of Ohio Inc.*, 878 F.2d 1446, 12 USPQ2d 1076, 1077 (Fed. Cir. 1989), cert. denied, 493 U.S. 1058 (1990) (unpublished — not citable as precedent) (“The recitation of an additional advantage associated with doing what the prior art suggests does not lend patentability to an otherwise unpatentable invention.”). See M.P.E.P. § 2145 II. Furthermore, “--- motivation to combine references need not be identical to that of applicants in order to establish obviousness.” citing in re Dillon. The prior art need not express the same reason or motivation for making the composition as Appellants to establish unpatentability. In re Kemps, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1311 (Fed. Cir. 1996).

As to the dependent claims, if not taught or suggested, the limitations would have been obvious to the skilled artisan and with a reasonable expectation of success, i.e., any additional or particular claim parameters which may not be specifically set out in the references are considered to be inherent in the reference products or not to involve anything unobvious absent a showing to the contrary.

Response to Arguments

10. Applicant's arguments with respect to claims 1, 2, 4-7, 9, 10, 12-14, 16 & 17 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

11. Claim 15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

12. Claims 3 & 8 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. Claims 3, 8 & 15 are deemed allowable over Shinohara et al in combination with Okano as per one having ordinary skill in the art would not have been motivated to add a rosin compound

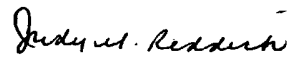
to the water-repellent glazing agent of either Shinohara et al or Okano with any reasonable expectation of success.


Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (571)272-1110. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR 
07/08/04